

REMARKS

This is in response to the Office Action of November 6, 2007. Claims 1-11 are pending in the present application, with claims 1-9 drawn to oil-control rings being examined on their merits and with method claims 10 and 11 being withdrawn from consideration. Claims 1-9 are amended to remove reference characters therefrom. This is a non-narrowing amendment. No new matter is introduced by this Amendment.

Rejections over Ishida

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 05-033866 (“Ishida”). Office Action, pages 2-3. Claims 2-4 and 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida in view of JP 2002-310299 (“Mitsuida”). Office Action, pages 3-4. Claims 5 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida and Mitsuida in view of JP 02-214796 (“Kato”). Office Action, pages 3-4. The rejections are respectfully traversed.

The Examiner argues at the top of page 3 of the Office Action that “the claimed and [Ishida’s] austenitic stainless steels are identical or substantially identical in structure or composition and are produced by identical or substantially identical gas nitriding processes The same phase would be expected on the surface of the austenitic stainless steel of [Ishida] as on the surface of the austenitic stainless steel after the nitriding process.”

Applicants respectfully disagree. As may be seen from the enclosed partial English translation of Ishida, Example 3 of Ishida corresponds to Comparative Example 1 in Applicants’ specification, because austenitic stainless steel is subjected to salt bath nitriding therein. In the

nitriding layer of Comparative Example 1 described in the present specification, S phases are not formed. It is noted that in Table 1, both of Applicants' steels have at least S1, S2, and S3 phases, while Comparative Example 1, analogous to Ishida, has no S phases at all. In other words, the "gas-nitriding surface layer comprising a phase having peaks at $2\theta = 40^\circ$ and $2\theta = 46^\circ$ by Cu-K α X-ray diffraction" as required by claims 1 and 6-9 is not formed in Ishida. This point regarding the difference in surface layers is evidenced by the aforementioned experimental data, which is summarized in Table 1 in Applicants' specification.

Additionally, evidence of unexpected superior results is presented in Table 3 of the specification. Product (H1) of Comparative Example 1 is compared therein to various products of the present invention (identified in Table 3 as "J" products). It is manifest that Applicants' products are far superior to the product of Comparative Example 1 (which is representative of Ishida), with respect to wear amount of inner peripheral surfaces of side rails and wear amounts of ears of spacer expanders. These unexpected beneficial properties of the presently claimed oil control rings covered by claims 1-9 must be taken into consideration when judging their patentability.

Conclusion

Withdrawal of all rejections of record is in order and is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher, Registration

No. 28,781, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,


By _____
Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant